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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,379	07/07/2003	David G. Foster	86697KNM	7425

7590 04/05/2005  
Paul A. Leipold  
Patent Legal Staff  
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343 State Street  
Rochester, NY 14650-2201

EXAMINER
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HESS, BRUCE H

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/614,379

Applicant(s)

FOSTER ET AL.

Examiner

Bruce H Hess

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1-17-05 (Prot Amdt.)
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 and 30-58 is/are pending in the application.
- 4a) Of the above claim(s) 1-25 and 30-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-25 and 30-58 is/are allowed.
- 6) ☒ Claim(s) 1-25 and 30-58 is/are rejected.
- 7) ☐ Claim(s) 1-25 and 30-58 is/are objected to.
- 8) ☐ Claim(s) 1-25 and 30-58 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 1-17-05 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No.         .
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1-21-05
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

1. Claims 1-25 and 30-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over the patent to Hatada et al (U.S.P. 6,103,042) in view of either of the patents to Henzel et al (U.S.P. 4,866,026 and U.S.P. 4,916,112).

The primary reference teaches a thermal dye transfer donor element having a slipping layer which contains a polyolefin-maleic anhydride copolymer. The secondary references teach that wax is a conventional additive in thermal dye transfer slipping layers. Since these separately taught ingredients perform the same function (i.e., slipping agents), their use in combination (i.e., a mixture of polyolefin-maleic anhydride copolymer and waxes) would have been an obvious expedient to one of ordinary skill in this art in the absence of unexpected results. In re Crockett, 125 USPQ 186.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 13-25, 30 and 58 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 10/614,600 in view of the patent to Hatada et al. The

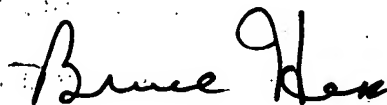
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claims of S.N. 10/614,600 recite a thermal dye transfer donor element having a slipping layer which employs a branched -olefin polymer. Hatada et al teaches the advantages of employing polyolefin-maleic anhydride copolymer as a slipping agent on the back of thermal dye transfer donor elements. Use of these separately taught ingredients (i.e., branched -olefin polymer and polyolefin-maleic anhydride copolymer) which perform the same function (slipping agents) in combination would have been obvious to one of ordinary skill in this art in the absence of unexpected results.

This is a provisional obviousness-type double patenting rejection.

Any inquiry concerning this communication should be directed to Bruce Hess at telephone number (571) 272-1525.

B.H. Hess/dh  
March 15, 2005



BRUCE H. HESS  
PRIMARY EXAMINER  
GROUP 1300